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APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,823	06/07/2003	John Dinklee	KLR 1076-068	1183

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EXAMINER

KARLSEN, ERNEST F.

ART UNIT PAPER NUMBER

2829

DATE MAILED: 01/29/2003

Please find below and or attached an Office communication concerning this application or proceeding.

Application No.

Applicant(s)

09/877.823

DUNKLEE JOHN

Office Action Summary

Examiner

Art Unit

Ernest F. Karlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-77 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 26, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - II. Claims 17-25 and 27-29, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - III. Claims 30-43, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - IV. Claim 44, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - V. Claims 45-52, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - VI. Claims 53-62, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - VII. Claims 63-67, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - VIII. Claims 68-72, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
 - IX. Claims 73-77, drawn to a chuck for a probe station, classified in class 324, subclass 158.1.
9. The inventions are distinct, each from the other because:

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10. Inventions I in a first set and II-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombinations are not required for the combination and at least claim 1 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

11. Inventions II in a first set and III-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombinations are not reacquired for the combination and at least claim 17 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

12. Inventions III in a first set and IV-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the

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combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombinations are not required for the combination and at least claim 30 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

13. Inventions IV in a first set and V-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the ^{sub-combinations} combinations are not reacquired for the combination and claim 44 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

14. Inventions V in a first set and VI-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP

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§ 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombinations are not required for the combination and at least claim 45 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

15. Inventions VI in a first set and VII-IX in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombinations are not required for the combination and at least claim 53 serves as an evidence claim that such is the case. The subcombination has separate utility such as each by themselves for their intended purpose or in a different combination.

16. Inventions VII in a first set and VIII and IX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombination. The subcombinations

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are not required for the combination and at least claim 63 serves as an evidence claim that such is the case. ^{The subcombination has separate utility such as} each by themselves for their intended purpose or in a different combination.

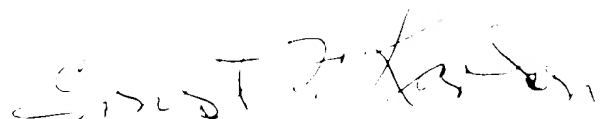
17. Inventions VIII and IX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombination are not required for the combination and at least claim 68 serves as an evidence claim that such as the case. The subcombination has separate utility such as by itself for its intended purpose or in a different combination.

18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

19. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Karlsen ds

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ERNEST KARLSEN
PRIMARY EXAMINER